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In re Application of JEN et al
U.S. Application No.: 09/646,478
Int. Application No.: PCT/US99/06947
Int. Filing Date: 30 March 1999
Priority Date: 31 March 1998
Attorney Docket No.: 126881201800
For: METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER

DECISION

This is in response to applicants' "Response to Notification of a Defective Response" filed 21 May 2001 which is being treated as a request to correct inventorship.

BACKGROUND

On 30 March 1999, applicants filed international application PCT/US99/06947, which claimed priority of an earlier United States application filed 31 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 September 2000.

On 15 September 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 17 January 2001, applicants filed a "Response to Notice of Missing Requirements" which included, *inter alia*, a declaration, an assignment document, and the required late declaration surcharge.

On 20 April 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed 17 January 2001 is improper since the declaration lists an inventor who is not listed on the international application.

On 21 May 2001, applicants filed the present response.

DISCUSSION

The declaration filed 17 January 2001 lists David Sidransky as an additional inventor beyond those indicated in the international application.

The present response states that submission of the declaration should act to correct the inventorship pursuant to 37 CFR 1.48(f)(1). However, 37 CFR 1.48(f)(1) specifically refers to nonprovisional applications filed under 37 CFR 1.53(b). MPEP 201.06(c) states in relevant part, "37 CFR 1.53(b) is the section under which all applications are filed EXCEPT: (1) an application resulting from entry of an international application into the national stage under 35 U.S.C. 371 and 37 CFR 1.494 or 37 CFR 1.495. . . ." As the present application was filed under 35 U.S.C. 371, correction of inventorship cannot be effected under 37 CFR 1.48(f)(1).

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With regard to item (1) above, applicant has not provided the requisite statement from the purported inventor Sidransky.

With regard to item (2) above, the requisite fee has not been provided.

With regard to item (3) above, the written consent of the assignee has not been provided.

Therefore, none of the requirements of 37 CFR 1.497(d) have been satisfied.

The declaration filed 17 January 2001 is also improper for the following additional reason. It is not sufficient to submit only the signature page of the declaration.¹ Applicant must file either

¹ It is noted that the assignment document filed 17 January 2001 is improper for the same reason.

1) a single complete declaration signed by all of the inventors or 2) multiple complete declarations, with each inventor's signature appearing on one of the multiple complete declarations.

CONCLUSION

For the reasons above, the request to correct inventorship is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and should also include a properly executed declaration and the items set forth in 37 CFR 1.497(d). Extensions of time may be obtained pursuant to 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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